



PATENT

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Date of Signature and Deposit: May 30, 2006


Jack M. Cook, Reg. No. 56,998

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s):	Gary H. Knauf
Serial No.:	09/978,524
Filed:	October 26, 2001
Examiner:	Tsoy, Elena
Group Art Unit:	1762
Docket No.:	119236.00013
Title:	Method for Extrusion Coating a Lightweight Web

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant, Knauf, having filed a timely Notice of Appeal of a Final Action in the above-identified patent application, hereby submits this Appeal Brief in support of patentability.

I. REAL PARTY IN INTEREST

The present application is assigned to Thilmany, LLC, 600 Thilmany Rd., Kaukauna, WI 54130, as evidenced by the assignment recorded at Reel/Frame No. 016164/0284.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-21 are pending in the present application, of which claims 1-12 have been finally rejected under 35 U.S.C. §103(a) and claims 13-21 have been withdrawn from consideration.

IV. STATUS OF AMENDMENTS

No amendment has been submitted by Appellant after the Final Office Action of October 28, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 is directed to a method for extrusion coating a lightweight web. See pg. 4, ll. 8-10. The method includes feeding a length of lightweight web 12 along with a length of carrier web 20 to an extruder 34 with the lightweight web 12 atop the carrier web 20. See pg. 5, l. 17 to pg. 7, l. 27. The method also includes extruding a polymer film coating 14 onto the lightweight web 12 and carrier web 20 in the extruder 34 so that a surface of the lightweight web 12 is coated by the extruded coating 14 to provide an extrusion-coated lightweight web 10. See pg. 8, ll. 25-26. Accordingly, the method includes separating the extrusion-coated lightweight web 10 from the carrier web 20. See pg. 9, ll. 16-18.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 3-4, and 6-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Backwell (U.S. Patent No. 3,620,872) in view of Marrocco, III et al. (U.S. Patent No. 5,646,231). Additionally, claims 1-4 and 6-11 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Peterson (U.S. Patent No. 3,840,421) in view of Backwell and in further view of Marrocco, III et al. Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Backwell in view of Marrocco, III et al. in further view of Anderson (U.S. Patent No. 4,963,303). Finally, claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Backwell in view of Marrocco, III et al. in further view of Enlow et al. (U.S. Patent No. 6,254,712).

VII. ARGUMENT

Claims 1, 3-4, and 6-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Backwell (U.S. Patent No. 3,620,872) in view of Marrocco, III et al. (U.S. Patent No. 5,646,231).

The burden of establishing a *prima facie* case of obviousness falls on the examiner. MPEP § 2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case of obviousness, the examiner must not only show that the combination includes each and every element of the claimed invention, but also provide “a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). That is, “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP § 2143.01.

In the case at hand, Appellant believes that a *prima facie* case of obviousness has not been made based on the art of record because, as will be shown below, (1) the references are directed to very different purposes and there is no motivation to combine these references in the way done so by the Examiner, other than Appellant’s own teaching; (2) the combination would not have a reasonable expectation of success; and (3) all of the elements of the present claims are not present in the references. The Examiner has not established the three basic criteria required under MPEP § 2143 and; thus, favorable consideration is respectfully requested.

With respect to claim 1, the Examiner has maintained that the claim is unpatentable over Backwell in view of Marrocco, III et al. Backwell teaches a method for making a multi-layer web laminated material using a reusable carrier.

See Title and Background of Backwell. In particular, Backwell teaches “a carrier web 2...coated with a layer 4 to 12 grams per square meter...followed by the application of print 6.” Col. 2, ll. 5-8. Backwell states, “A suitable primer was applied on the printed surface before an extrusion coating of...polyethylene film 8.” Col. 2, ll. 8-11. Thus, the Examiner analogized the layer that is extrusion coated onto the carrier web in Backwell with the claimed lightweight web.

The Examiner acknowledged that Backwell does not teach that the extrusion coating is formed separately from the carrier web, as required by claim 1. See Office Action of February 25, 2005, pg. 5. In an attempt to rectify this deficiency, the Examiner cited column 21, lines 5-9 of Marrocco, III et al., which states, “Coatings may also be formed by any of the established techniques, including but not limited to: coating from solution, spray coating of solution, spin coating, coating from a latex, powder coating, laminating preformed films, spray coating molten droplets, and coating from the melt.” *Id.* From this statement, the Examiner concluded, “In other words, Marrocco, III et al. teach that laminating preformed films is **functionally equivalent** to coating from melt, solution or latex.” *Id (emphasis added).* Further still, the Examiner concluded from this same statement that “Marrocco, III et al. teach that the same properties would be achieved whether coating is made from preformed films or from melt, solution or latex.” Office Action of October 28, 2005, pg. 5. Appellant respectfully disagrees and does not believe that the asserted conclusion is supported by the cited section or by any portion of Marrocco, III et al.

Marrocco, III et al. is directed to rigid-rod polymers and blending the polymers with thermoplastic polymers to achieve improved strength properties for high performance composite materials. See Col. 1, ll. 15-25. In this regard, Marrocco III et al. teaches that various blends were tested using these commercial coating and film forming processes but, contrary to the position of the Examiner, does **not** state that polymer coatings are “functionally equivalent” or would yield the “same properties” no matter how they are processed. Rather, one of ordinary skill in the art would readily recognize that laminating preformed films does not necessarily yield a “functional equivalent” having the “same properties” as coatings created by other processes (e.g. extrusion coating).

In particular, one of ordinary skill in the art would recognize that the art of record teaches a preformed film laminate, which in the art is biaxially oriented to yield substantial strength against tearing along both the length and width of the film laminate. On the other hand, one of ordinary skill in the art would also readily recognize that, since the claimed film is "extruded", it is stretched linearly along its length and, thus, only yields substantial resistance tearing in one direction. Thus, preformed film laminates and extruded films are not functionally equivalent as asserted by the Examiner.

In addition, the Examiner overlooked that Marrocco, III et al. teaches that the extruded lightweight web would be adhered over its entire surface area to the carrier web and so the Examiner relied on just one layer of a laminate (the laminate being the extruded layer and the carrier web) to find the claimed lightweight web. Substituting a preformed film for the extruded layer, it would also have to be laminated to the carrier web in Marrocco, III et al. to obtain a structure according to the Marrocco, III et al. teachings, absent Appellant's teaching that the lightweight web is separate from the carrier web.

Therefore, contrary to the assertions by the Examiner, one of ordinary skill in the art would appreciate that there is a distinct functional difference between a laminate of an extruded film and a carrier web and a preformed film that is separate from the carrier web. Hence, the art of record fails to disclose or suggest the claimed invention.

Furthermore, Appellant contends that there is simply nothing in the cited references that would have led or suggested to a person of ordinary skill in the art to try the claimed combination, and that, from the teachings of the cited references, a person of ordinary skill in the art would not have had any reasonable expectation of success of the claimed combination. As such, the proffered rejection is insufficient to establish a *prima facie* case of obviousness. Accordingly, Appellant believes claim 1 is patentably distinct from the art of record.

Regarding claim 3, the Examiner asserted without any cited support that "the method of Backwell in view of Marrocco, III et al. can be used for treating *any* lightweight material that would require a support to be treated without deformation" Office Action of February, 25, 2005, (emphasis in original). The art of record

clearly does not support such a sweeping conclusion. Nevertheless, claim 3 is far less broad than the conclusion presented to reject it. Claim 3 simply calls for the lightweight web to exhibit “deformations when subjected to a tension of about 0.5 pli or less.” The art of record does not include any teachings or suggestions that the systems and methods included therein could be extended to such a specific definition of “lightweight”. The Examiner cannot simply sidestep claim elements by unilaterally concluding that the art can be applied to “*any*” material. Rather, the MPEP is clear that “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP § 2143.01. In the case at hand, the Examiner has not established that the art of record includes any such teaching, suggestion, or motivation (explicit or implicit). Hence, the Examiner has failed to meet the burden required to establish a *prima facie* case of obviousness.

The Examiner did not directly address the elements of claims 6 and 7 in any of the rejections but, when addressing claim 1, merely cited that Backwell states that some of the layers may include “polyethylene or polypropylene, ethylene-vinyl acetate copolymer or vinylidene chloride copolymers or regenerated cellulose film, paper, board, metal foil or other material to which it is desired to apply a coated finish.” Col. 1, ll. 59-64. However, reading deeper into Backwell, it is clear that the paper, board or foil layers referred to were intended to be layers that were laminated on top of the lightweight web, not the lightweight web itself. See col. 2, ll. 43-75 and col. 3, lines 11-22. That Backwell teaches laminating these materials to the lightweight web, and not using them as the lightweight web itself, should be evidence enough of the inapplicability of Backwell and the non-obviousness of Appellant's invention in view thereof. Appellant contends that the Examiner has therefore failed to address each and every element of claims 6 and 7 as required by MPEP § 2143 and; thus the proffered rejection has not met the burden required to establish a *prima facie* case of obviousness.

Regarding claim 8, which calls for the lightweight web to have “a MD curl of less than about 3 inches as measured by TAPPI UM 427”, the Examiner also did not

address the elements of the claims. Rather, the Examiner simply concluded that these very specific limitations were taught because, as previously addressed, the Examiner concluded that “the method of Backwell in view of Marrocco, III et al can be used for treating *any* lightweight material that would require a support to be treated without deformation.” Office Action of February, 25, 2005, pg. 6 (emphasis in original). Appellant believes that this unsupported conclusion falls short of the requirements for establishing a *prima facie* case of obviousness, as set forth in MPEP §2143. The Examiner cannot simply supplant the requirement to provide objective evidence with unsupported conclusion. Hence, Appellant maintains that the rejection presented against claim 8 cannot be sustained.

For at least the foregoing reasons, claims 1, 3-4, and 6-11 are patentably distinct from the proffered combination of Backwell and Marrocco, III et al. and favorable consideration is respectfully requested.

Claims 1, 3-4, and 8-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Peterson (U.S. Patent No. 3,840,421) in view of Backwell and in further view of Marrocco, III et al.

Though, as addressed above, the Examiner rejected claims 1, 3, 4, and 6-11 as unpatentable over Backwell in view of Marrocco, III et al., the Examiner also rejected claims 1, 3, 4 and 8-11 as unpatentable over Peterson in view of Backwell and in further view of Marrocco, III et al. Thus, the Examiner provided two distinct bases of rejection for claims 1, 3, 4, and 8-11. In this regard, Appellant questions, if the combination of Backwell and Marrocco, III et al. was sufficient to establish a proper rejection of claims 1, 3, 4, and 8-11, why is the addition of Peterson necessary or is this basis of rejection merely duplicative? If the latter is the case, Appellant objects to the rejection under MPEP § 904.03, which states that “[t]he examiner is not called upon to cite all references that may be available, but only the ‘best’” because “[m]ultiplying references [or combinations of references], any one of which is as good as, but no better than, the others, adds to the burden and cost of prosecution and should therefore be avoided.” (Emphasis in original). If this is the case, Appellant asserts that claims 1, 3, 4, and 8-11 are patentably distinct from the art of record for the reasons addressed above. On the other hand, assuming

arguendo that the addition of Peterson is not duplicative, Appellant asserts that the addition of Peterson to the previous rejection does not serve to rectify the *prima facie* case of obviousness shown to be lacking with respect to the combination of Backwell and Marrocco, III et al.

In particular, Peterson is directed to a stainless steel carrier belt. Col. 3, ll. 10-14. A stretchable vinyl material is adhered to the belt with an adhesive to prevent slippage or wrinkling of the vinyl film. Col. 3, ll. 25-65. A printing layer is applied thereon and covered with a protective clear vinyl. Col. 4, ll. 55-61. The combination of the stretchable vinyl material, the printing, and the protective clear vinyl layer are then stripped from the adhesive to form the desired product. Col. 5, ll. 23-32.

The Examiner equated the protective clear vinyl with the extrusion coating called for in claim 1 based on the statement that "Peterson fails to teach that the protective clear vinyl material 72 is added to the web 44 by extrusion coating." Office Action of February 25, 2005, pg. 7. The Examiner attempted to rectify this deficiency in the art of record by applying Marrocco, III et al. also, stating "Marrocco, III et al. teach that coating may be formed either by laminating preformed films or right on a substrate from e.g. melt, solution or latex, powder (See column 21, lines 5-9)." Office Action of February 25, 2005, pg. 7.

Marrocco does not disclose or suggest substituting an extruded coating for a preformed film of Peterson, any more than it discloses or suggests substituting a preformed film for the extruded coating of Backwell. The same arguments apply. In addition, Peterson adheres the lightweight web to the carrier belt prior to applying the top layer to the lightweight web, like Backwell does but contrary to the teachings of the invention. Hence, these rejections simply must fail. Clearly the Appellant's disclosure is being used as a guide to make these rejections, which is improper under MPEP § 2142.

Additionally, Marrocco, III et al. requires an adhesive in order to affix the preformed film laminates to the web that it is designed to protect. Also, Peterson teaches that when using a carrier web to support a lightweight web, a low tack adhesive is necessary to keep the product from wrinkling in a nip such as a print press nip. Backwell extrudes the lightweight web onto the carrier so adhesion is

inherent. Hence, the art of record teaches the use of an adhesive that is used to affix the these elements prior to processing/coating.

While such teachings are well known in the art, and in the present invention the lightweight web can be adhered to the carrier web after the coating is applied to facilitate subsequent processing (see Claim 2 discussion below in which it is done at the edges by the coating overlapping onto the carrier web), the present invention does not require adhering the lightweight web to the carrier prior to coating, as is done in Peterson and Backwell. Thus, no adhesive is needed to practice the present invention. In this regard, one of ordinary skill in the art would not look to Peterson or Backwell when attempting to create the claimed invention because both teach a system and method plagued by one of the drawbacks overcome by the present invention.

When addressing this point, the Examiner attempted to sidestep these distinctions by merely stating, "The claims do not recite a negative limitation about the adhesive." Office Action of October 28, 2005, pg. 6. This statement is indicative of the Examiner's failure to appreciate the teachings of the art and, in particular, the teaching inherent in the art that one of ordinary skill in the art would understand as teaching away from the combination proffered by the Examiner. That is, Appellant did not present this distinction because some "negative limitation" regarding a lack of adhesive appears in the claims. Rather, Appellant provided this as evidence that one of ordinary skill in the art looking to create the claimed invention would not look to combine the art cited by the Examiner.

Therefore, for the reasons addressed above with respect to the combination of Backwell and Marrocco, III et al., as well as the reasons set forth above establishing that the addition of Peterson does not rectify but exacerbates the deficiency of the rejection, claim 1 is patentably distinct from the proffered combinations.

With respect to claims 3, 4, and 8-11, the Examiner did not provide any additional remarks to support a rejection of the claims that was separate from the rejection based upon the combination of Backwell and Marrocco, III et al. without Peterson. As such, for the reasons listed above, Appellant asserts that the Examiner

has failed to establish a *prima facie* case of obviousness. Hence, claims 1, 3, 4, and 8-11 are patentably distinct from the art of record.

Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Peterson (U.S. Patent No. 3,840,421) in view of Backwell (US 3,620,872) and in further view of Marrocco, III et al (US 5,646,231).

The Examiner acknowledged that Peterson (and the other art of record) fails to teach that the width of the protective clear vinyl material 72 is wider than the width of the web 44 to be protected, but concluded that it would have been obvious to use a protective clear vinyl material 72 that is wider than a web 44 with the expectation of providing protection of the edges of the web 44.

However, this proffered justification is not the reason for Appellant overlapping the coating onto the carrier web and has no basis. The lightweight web and carrier web in the invention are preferred to be "temporarily affixed to one another as this will facilitate initially collecting both finished webs on a single windup stand for later separation using a rewinder. This allows automatic roll changes to be made at the windup stand at or near full line speed. For this purpose, the webs 10, 20 need only be joined along a portion of the webs 10, 20." Specification, pg. 9, l. 28 to pg. 10, l. 2. Protecting the edges is off point, and what that has to do with temporarily adhering the lightweight web to the carrier is not explained in the Office Actions.

Accordingly, there is no disclosure or suggestion of the invention of claim 2 in the prior art of record.

Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Backwell in view of Marrocco, III et al. in further view of Anderson (U.S. Patent No. 4,963,303).

Claim 5 calls for the lightweight web to be a nonwoven fabric. The Examiner acknowledged that neither Backwell nor Marrocco, III et al. teaches or suggests such a construction for the lightweight web and, hence, cited Anderson as teaching that a "metal plate or moving non-woven fabric backing can be used as a suitable support for applying a casting solution in certain applications." Office Action of February 25, 2005, pg. 8. However, Anderson is directed to an "ultrafiltration

polyimide membrane and its use for recovery of dewaxing aid.” Title of Anderson. Accordingly, Appellant does not believe that Anderson is analogous to Backwell or Marrocco, III et al. or even the present invention. Appellant does not believe that a reference that teaches the use of a fabric as part of a filtration system is related to a method for making laminated webs (Backwell), a method of producing rigid-rod polymers (Marrocco, III et al.), or, most importantly, the claimed method for extrusion coating a lightweight web. Therefore, MPEP § 2141.01 is clear that such nonanalogous art can not be cited as a basis of rejection against the claimed invention. Accordingly, the rejection proffered with respect to claim 5 cannot be sustained.

Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Backwell in view of Marrocco, III et al. in further view of Enlow et al. (U.S. Patent No. 6,254,712).

Claim 12 calls for the polymer film coating to include “a coextrusion of at least two layers of polymer films.” When addressing claim 12, the Examiner acknowledged that neither Backwell nor Marrocco, III et al. includes such a teaching or suggestion. Accordingly, the Examiner cited Enlow et al., which simply states that when producing protective and decorative films that are comprised of a clear coat, a color coat, and a size coat, these coats may be coextruded as a multi-layer film onto a traditional carrier. Col. 14, ll. 1-7. Nowhere does Enlow et al. teach or suggest the application of coextruded polymer films onto a lightweight web, which traditionally could not withstand such an extrusion process without deformation, as claimed.

Accordingly, Enlow et al. teaches nothing more relevant to the claimed invention that to establish that coextrusion of films is known. However, Appellant has not attempted to claim the coextrusion of films onto a traditional carrier as novel. Rather, as addressed above, the prior art does not teach or suggest the ability to apply an extrusion coating to a lightweight web that is separable from a carrier web on which it resides. In this regard, the additional element of a coextruded, dual-layer, polymer film coating further distinguishes the claimed invention from the art of record. For at least these reason, claim 12 is patentably distinct form the art as applied.

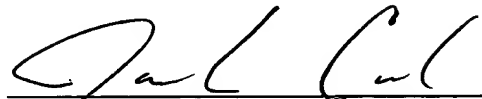
VIII. CONCLUSION

In view of the above, Appellant requests reversal of the final rejection regarding claims 1-12 and a Notice of Allowance.

Respectfully submitted,

Dated: May 20, 2006

By:



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APPENDIX A
Claims of Patent Application No. 09/978,524

1. (Original) A method for extrusion coating a lightweight web comprising:
feeding a length of a lightweight web along with a length of carrier web
to an extruder with the lightweight web atop the carrier web;
extruding a polymer film coating onto the lightweight web and carrier
web in the extruder so that a surface of the lightweight web is coated by the extruded
coating to provide an extrusion-coated lightweight web; and
separating the extrusion-coated lightweight web from the carrier web.
2. (Previously Presented) The method of claim 1 wherein the lightweight
web has a width less than a width of the carrier web and is affixed to the carrier web
by the polymer film coating, and wherein a width of the polymer film coating is greater
than the width of the lightweight web.
3. (Original) The method of claim 1 wherein the lightweight web exhibits
deformations when subjected to a tension of about 0.5 pli or less.
4. (Original) The method of claim 1 wherein the polymer film coating
comprises a polymer selected from the group consisting of low density polyethylene
(LDPE), polyolefin plastomers (POP), polyolefin elastomers (POE), linear low density
polyethylene (LLDPE), high density polyethylene (HDPE), polypropylene (PP),
ethylene methyl acrylate copolymer (EMA), ethylene butyl acrylate copolymer (EnBA),
ethylene vinyl acetate copolymer (EVA), ethylene acrylic acid copolymer (EAA),
ethylene methyl acrylic acid copolymer (EMAA), ionomoers, ethylene vinyl alcohol
(EVOH), polyesters such as polyethylene terephthalate (PET), polyamides, and one or
more of the foregoing.
5. (Original) The method of claim 1 wherein the lightweight web is a
nonwoven fabric.
6. (Original) The method of claim 1 wherein the lightweight web is a paper
web.
7. (Original) The method of claim 1 wherein the lightweight web is a metal
foil.

8. (Original) The method of claim 1 wherein the lightweight web has a MD curl of less than about 3 inches as measured by TAPPI UM 427.

9. (Original) The method of claim 1 wherein the lightweight web has insufficient strength properties in the absence of the underlying carrier web to withstand forces imposed upon it in an extruder coating station.

10. (Original) The method of claim 1 wherein the carrier web is a heavyweight web.

11. (Original) The method of claim 1 wherein the carrier web is a second lightweight web.

12. (Original) The method of claim 1 wherein the polymer film coating comprises a coextrusion of at least two layers of polymer films.

13. (Withdrawn) A coated web product comprising:
a lightweight web; and
a polymer coating extrusion coated thereon wherein the lightweight web is substantially undeformed.

14. (Withdrawn) The product of claim 13 wherein the lightweight web is a nonwoven fabric.

15. (Withdrawn) The product of claim 13 wherein the lightweight web is a paper web.

16. (Withdrawn) The product of claim 13 wherein the lightweight web is a metal foil.

17. (Withdrawn) The product of claim 13 wherein the lightweight web exhibits deformations when subjected to a tension of about 0.5 pli or less.

18. (Withdrawn) The product of claim 13 wherein the lightweight web has a MD curl of less than about 3 inches as measured by TAPPI UM 427.

19. (Withdrawn) The product of claim 13 wherein the polymer coating extruded onto the lightweight web is a polymeric film comprising a polymer selected from the group consisting of extruded low density polyethylene (LDPE), polyolefin

plastomers (POP), polyolefin elastomers (POE), linear low density polyethylene (LLDPE), high density polyethylene (HDPE), polypropylene (PP), ethylene methyl acrylate copolymer (EMA), ethylene butyl acrylate copolymer (EnBA), ethylene vinyl acetate copolymer (EVA), ionomers, ethylene vinyl alcohol (EVOH), polyesters such as polyethylene terephthalate (PET), polyamides, and one or more of the foregoing.

20. (Withdrawn) The product of claim 13 wherein the polymer coating comprises a coextrusion of at least two layers of polymer films.

21. (Withdrawn) A product formed according to the method of claim 1.



APPENDIX B EVIDENCE

There is no evidence, other than the documents cited in the final Office Action.

APPENDIX C
RELATED PROCEEDINGS

There are no decisions in related proceedings.